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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,021	02/10/2006	David R. Curry	03-1051-B	7384
20306 7590 02/17/2009 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
KAVANAUGH, JOHN T				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
02/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/568,021

Applicant(s)

CURRY, DAVID R.

Examiner

/Ted Kavanaugh/

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12 and 14-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-19-2009 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,4,5,7-12,14-17,19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5144759 (Mascotte).

Mascotte teaches an interchangeable upper portion (18) defining an outer perimeter (22), one or more releasable fasteners (20 or 30) disposed along the outer perimeter, and one or more alignment mechanisms (VELCRO 34; see figures 5 and 6)

located away from the outer perimeter for aligning the interchangeable upper portion to an article of footwear (10); said article of footwear (10) having a fixed upper (14), a fixed sole (12), one or more releasable fasteners (16 or 32) and one or more alignment mechanisms (VELCRO 36) disposed on the fixed upper away from the outer perimeter. The alignment mechanisms extend above and along the releasable fasteners (30,32; see col. 2, lines 58-68) wherein the fasteners extend substantially around the perimeter of the interchangeable upper portion and the article of footwear and therefore are disposed in a rear portion of both. Mascotte has all the structures as claimed and therefore is inherently capable of satisfy all of the functional language as claimed. The interchangeable upper portion (18) is made out of breathable material, see col. 2, lines 13-24

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mascotte '759 in view of Official Notice.

Mascotte teaches footwear and an interchangeable upper portion as claimed (see the rejection above) except for the component having shoelaces. Mascotte teaches the interchangeable upper portion (18) having VELCRO fasteners (26,28) but teach other fastening devices can of course be used (see col. 2, lines 41-54). The examiner takes official notice that VELCRO fasteners and shoelaces are art recognized equivalents, especially in the footwear art. Therefore, it would have been obvious to substitute the VELCRO fasteners of Mascotte with shoelaces to facilitate tightening the upper portion on to the footwear.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mascotte '759 in view of US 5505011 (Bleimhofer).

Mascotte teaches footwear and an interchangeable upper portion as claimed (see the rejection above) except for the fixed upper portion made out of a breathable material. Bleimhofer teaches it is known in the art to provide footwear with a waterproof breathable upper (see the disclosure). It would have been obvious to provide the fixed upper of Mascotte with a waterproof breathable upper, as taught by Bleimhofer, to further enhance the footwear system with a waterproof and breathable system.

7. Claim 30 and 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mascotte as applied to claim 23 above, and further in view of US 2302596 (Bigio).

Bigio teaches an article of footwear wherein the upper and the sole are releasably retained by a zipper disposed along the outer perimeter of the footwear and extend away from the sole at a heel portion of the article of footwear (see figures 2 and 3 and page 1, col. 1, line 52 to col. 2, line 11). It would have been obvious to substitute the releasable fasteners (hook and loop 26 and 28) of Mascotte with a zipper extending around the outer perimeter and away from sole at the heel, as taught by Bigio, to facilitate removing the upper and spreading them to facilitate storing of different uppers.

Response to Arguments

8. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM. If attempts to reach the examiner

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by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (In United States OR CANADA) or 571-272-1000.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
February 13, 2009